

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-11 and 19 have been amended to more clearly recite the invention. No new matter has been added. Claims 1-19 are pending.

Rejection of claims 1, 2 and 5 under 35 U.S.C. 103(a)

Claims 1, 2, and 5 were rejected under 35 U.S.C. 103(a) for allegedly being unpatentable over Boucher et al. (U.S. Patent No. 5,884,246). Applicants respectfully traverse these rejections.

Claim 1, as amended, recites comparing a portion of the data to be translated to previously stored data in the storage memory to identify a plurality of matching corresponding previously translated data strings and selecting one of the matching corresponding previously translated data strings based on predetermined criteria.

Boucher fails to teach or suggest comparing a portion of the data to be translated to previously stored data in a storage memory. The Office Action asserts that data of Boucher “would inherently be stored or buffered in order to be translated and the corresponding translated data would inherently be stored or buffered in order to be transmitted to the secondary translation machines, col. 12, lines 40-63.” See Office Action, page 3. However, the fact that a certain result or characteristic may occur in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re*

Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981) (holding that “to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient”) (emphasis added).

Even assuming *arguendo* that Boucher’s system necessarily contains a storage memory, Boucher nevertheless fails to teach or suggest previously stored data in the storage memory/buffer or comparing the portion of the data to be translated to the previously stored data in the storage memory. Nor is it “inherent” that Boucher provides this teaching because the system of Boucher does not necessarily compare the data to be translated to previously stored data in the storage memory.

Boucher also fails to teach or suggest selecting one of a plurality of matching corresponding previously translated data strings. Boucher fails to teach or suggest a plurality of matching previously translated data strings at all.

Therefore, for at least the reasons set forth above, it is respectfully submitted that the rejection of claims 1, 2 and 5 should be withdrawn.

Rejection of claims 3, 4, and 19 under 35 U.S.C. 103(a)

Claims 3, 4, and 19 were rejected under 35 U.S.C. 103(a) as being obvious over Boucher in view of Goldberg et al. (U.S. Patent No. 6,161,082). This rejection is respectfully traversed.

Claims 3 and 4 depend from claim 1. As set forth above, Boucher fails to teach or suggest selecting one of the matching corresponding previously translated data strings from the plurality of matching corresponding previously translated data strings based on predetermined criteria. Goldberg fails to cure the deficits of Boucher.

The Office Action asserts that Goldberg discloses “a network based language translation device that uses previously translated sentences that are stored in a database for translation (col. 4, lines 9-22).” See Office Action, page 4. However, Goldberg merely translates sentences by using a library of translated sentences. Goldberg fails to teach or suggest identifying a plurality of matching previously translated data strings and selecting the data strings based on predetermined criteria.

Claim 19, as amended, recites selecting one of the corresponding translated document data of the plurality of corresponding translated document data based on one of a most frequently used data and a most recently used data. Neither Boucher nor Goldberg, either alone or in combination, teaches or suggests selecting a translated document data from a plurality of translated document data based on one of a most frequently used data and a most recently used data. It is well established that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

The combination of Boucher and Goldberg fails to teach or suggest all elements of claims 1, 3, 4, or 19. Therefore, the rejection should be withdrawn.

Rejection of claims 6-9 under 35 U.S.C. 103(a)

Claims 6-9 were rejected under 35 U.S.C. 103(a) as being obvious over Boucher in view of Nishino (U.S. Patent No. 5,295,068). This rejection is respectfully traversed.

Neither Boucher nor Nishino, either alone or in combination, teaches or suggests comparing a portion of the data to be translated to the previously stored data in the storage memory to identify a plurality of matching corresponding previously translated data strings and selecting one of the matching corresponding previously translated data strings from the plurality of matching corresponding previously translated data strings based on predetermined criteria. Therefore, the rejection should be withdrawn.

Claim 6 further recites a means for transmitting an E-mail message to the source of data identifying a network link to an address from which said completed translation can be downloaded. Claim 7 recites transmitting an E-mail message to a translation source identifying a network link to an address from which a partially completed translation can be downloaded. The Office Action “takes Official Notice that network links are notoriously well known in the art” and contends that it would therefore have been obvious to “include a network link.” See Office Action, pages 7-8. However, even assuming *arguendo* that network links are “notoriously well known in the art” as the Office Action asserts, it is not “notoriously well known in the art” to identify to a source of data to be translated (or to a translation source) a network link to an address from

which a completed translation (or partially completed translation) can be downloaded. The Office Action picks and chooses words from the claims, takes the selected words out of context and concludes that the elements are individually “notoriously well known in the art.” This is improper. It is well established that “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Therefore, it is respectfully submitted that the rejection is improper and should be withdrawn.

Claim 9 recites combining translated glossaries from multiple sources. The Office Action asserts Nishino discloses combining glossaries from multiple sources at col. 13, lines 40-58 (see Office Action, page 8). The Office Action’s assertion is incorrect. Nishino fails to teach or suggest combining glossaries from multiple sources. Rather, Nishino discloses at col. 13, lines 40-58 the use of 3 separate dictionaries. The rejection should be withdrawn.

Therefore, at least for the above reasons, it is respectfully submitted that the rejection of claims 6-9 should be withdrawn.

Rejection of claim 10 under 35 U.S.C. 103(a)

Claim 10 was rejected under 35 U.S.C. 103(a) as being obvious over Boucher in view of Goldberg and further in view of Thompson (U.S. Patent No. 5,644,775). This rejection is respectfully traversed.

Claim 10 depends from claim 1. As set forth above, Boucher and Goldberg fail to teach or suggest claim 1. Thompson fails to cure the deficits of Boucher and Goldberg.

Boucher, Goldberg and/or Thompson, either alone or in combination, fail to each or suggest comparing a portion of the data to be translated to the previously stored data in the storage memory to identify a plurality of matching corresponding previously translated data strings and selecting one of the matching corresponding previously translated data strings from the plurality of matching corresponding previously translated data strings based on predetermined criteria. Therefore, the rejection should be withdrawn.

Rejection of claims 11, 13, and 16 under 35 U.S.C. 103(a)

Claims 11, 13, and 16 were rejected under 35 U.S.C. 103(a) as being obvious over Boucher in view of Takeda et al. (U.S. Patent No. 5,895,446). This rejection is respectfully traversed.

Claim 11, as amended, recites collecting translation costs from a plurality of translation sources, the translation costs being based on a size of an untranslated portion of data to be translated. The Office Action admits that Boucher fails to teach or suggest collecting translation costs but relies on Takeda to provide this teaching. However, Takeda fails to cure the deficiencies of Boucher.

Takeda discloses calculating costs based on “translation patterns.” See Takeda, col. 11, lines 11-20. However, Takeda fails to teach or suggest translation costs being based on a size of an untranslated portion of data to be translated. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggest by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The

combination of Boucher and Takeda fails to teach or suggest all the claim limitations.

Therefore, the rejection should be withdrawn.

The Office Action admits that Boucher and Takeda both fail to teach or suggest a means for facilitating the user's selection of at least one of the plurality of translation sources but "takes Official Notice that allowing a user to select a processor for processing a set of data is notoriously well known in the art." See Office Action, page 10. It is first pointed out that claim 11 does not recite "allowing a user to select a processor for processing a set of data" as the Office Action asserts. Rather, claim 11 recites "means for facilitating the user's selection of at least one of the plurality of translation sources." Applicants maintain that this recitation, taken in context with claim 11 as a whole, is not "notoriously well known in the art" as the Office Action asserts. It is pointed out that it is improper to pick and choose terms in a claim and interpret the terms out of context to conclude that the isolated term is "notoriously well known in the art" because "... [A]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If the Office Action continues to assert that the "means for facilitating the user's selection of at least one of the plurality of translation sources" is "notoriously well known in the art" after consideration of all words in the claim, it is officially requested that the Office provide a reference to demonstrate this alleged "well-known" feature in the art.

Claims 13 and 16 depend from claim 11 and are allowable for at least the reasons set forth above for claim 11.

Therefore, for at least the reasons set forth above, it is respectfully submitted that the rejection of claims 11, 13, and 16 should be withdrawn.

Rejection of claim 12 under 35 U.S.C. 103(a)

Claim 12 was rejected under 35 U.S.C. 103(a) as being obvious over Boucher in view of Takeda and further in view of Redpath (U.S. Patent No. 6,347,316). This rejection is respectfully traversed.

Claim 12 depends from claim 11. As set forth above, Boucher and Takeda fail to teach or suggest claim 11. Redpath fails to cure the deficiencies of Boucher and Takeda.

Redpath also fails to teach or suggest a means for collecting translation costs from the plurality of translation sources, the translation costs being based on a size of an untranslated portion of data to be translated. Redpath also fails to teach or suggest a means for facilitating the user's selection of at least one of the plurality of translation sources. As stated above, a means for facilitating the user's selection of at least one of the plurality of translation sources is not "notoriously well known in the art" as the Office Action contends. If the Office Action continues to "take Official Notice" to that effect, documentary evidence in the form of a reference is requested.

Hence, the Office Action fails to establish *prima facie* obviousness. The rejection should be withdrawn.

Rejections of claim 14 and 15 under 35 U.S.C. 103(a)

Claim 14 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher in view of Takeda and further in view of Goldberg. This rejection is respectfully traversed.

Claims 14 and 15 depend from claim 11. As set forth above, neither Boucher nor Takeda, either alone or in combination, teach or suggest claim 11. Goldberg fails to cure the deficiencies of Boucher and/or Takeda.

Goldberg also fails to teach or suggest a means for collecting translation costs from the plurality of translation sources, the translation costs being based on a size of an untranslated portion of data to be translated. Goldberg also fails to teach or suggest a means for facilitating the user's selection of at least one of the plurality of translation sources. As stated above, a means for facilitating the user's selection of at least one of the plurality of translation sources is not "notoriously well known in the art" as the Office Action contends. If the Office Action continues to "take Official Notice" to that effect, documentary evidence in the form of a reference is requested.

For at least the reasons set forth above, it is respectfully requested that the rejection of claims 14 and 15 be withdrawn.

Rejection of claims 17 and 18 under 35 U.S.C. 103(a)

Claims 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boucher in view of Takeda and further in view of Nishino. This rejection is respectfully traversed.

Claims 17 and 18 depend from claim 11. As set forth above, Boucher and Takeda fail to teach or suggest claim 11. Nishino fails to cure the deficiencies of Boucher and Takeda.

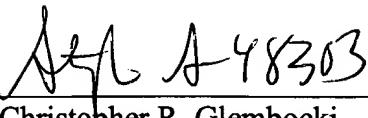
Nishino also fails to teach or suggest a means for collecting translation costs from the plurality of translation sources, the translation costs being based on a size of an untranslated portion of data to be translated. Nishino also fails to teach or suggest a means for facilitating the user's selection of at least one of the plurality of translation sources. As stated above, a means for facilitating the user's selection of at least one of the plurality of translation sources is not "notoriously well known in the art" as the Office Action contends. If the Office Action continues to "take Official Notice" to that effect, documentary evidence in the form of a reference is requested.

For at least the reasons set forth above, it is respectfully requested that the rejection of claims 17 and 18 be withdrawn.

Conclusion

Applicants respectfully submit that the instant application is in condition for allowance. If the Examiner feels, however, that further amendment and/or discussion may be helpful in facilitating prosecution of the case, the Examiner is respectfully requested to telephone the undersigned attorney of record at the number appearing below.

Respectfully submitted,


Christopher R. Glembocki
Registration No. 38,800

BANNER & WITCOFF, LTD.
1001 G Street, N.W.
Washington, D.C. 20001
(202) 508-9100

Date: August 9, 2005